

1 CHRISTOPHER L. PITET, SBN 196861  
cpitet@grobatypitet.com  
2 JOHN M. ALPAY, SBN 198127  
jalpay@grobatypitet.com  
3 GROBATY & PITET LLP  
4 100 Bayview Circle, Suite 210  
Newport Beach, California 92660  
5 Telephone: (949) 502-7755  
6 Facsimile: (949) 502-7762  
7 Attorneys for Plaintiff  
LUXOTTICA GROUP S.P.A.

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10 UNITED STATES DISTRICT COURT  
11 SOUTHERN DISTRICT OF CALIFORNIA  
12

13 LUXOTTICA GROUP S.P.A., an  
14 Italian corporation,

15 Plaintiff,

16 v.

17 WEB 4 HALF LLC, a North Carolina  
limited liability company; and  
18 DOES 1 through 10, inclusive

19 Defendants.  
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CASE NO. '15CV1665 JAH NLS

ASSIGNED FOR ALL PURPOSES TO:

COMPLAINT FOR:

1. TRADEMARK INFRINGEMENT;
2. FALSE DESIGNATION OF ORIGIN;
3. TRADEMARK DILUTION;
4. COMMON LAW TRADEMARK INFRINGEMENT; AND
5. UNFAIR COMPETITION.

DEMAND FOR JURY TRIAL

1 Plaintiff LUXOTTICA GROUP S.P.A. ("Luxottica" or "Plaintiff")  
 2 hereby complains of Defendant WEB 4 HALF LLC ("Defendant") and DOES  
 3 1 through 10, inclusive, and alleges as follows:

4 **I.**

5 **THE PARTIES**

6 1. Plaintiff is a corporation organized and existing under  
 7 the laws of the Republic of Italy, having its principal place of  
 8 business at Piazzale Luigi Cadorna 3, Milan, 20123 Italy.

9 2. Plaintiff is informed and believes, and thereon alleges,  
 10 that Defendant is a limited liability company organized and  
 11 existing under the laws of the state of North Carolina and has a  
 12 principal place of business at 2327 Englert Drive, Suite 302,  
 13 Durham, North Carolina 27713.

14 3. Plaintiff is informed and believes, and thereon alleges,  
 15 that Defendant regularly conducts business in, and has committed  
 16 the acts alleged herein, within this judicial district.

17 **II.**

18 **JURISDICTION AND VENUE**

19 4. This is an action for (a) trademark infringement arising  
 20 under 15 U.S.C. § 1114, (b) false designation of origin arising  
 21 under 15 U.S.C. § 1125(a), (c) trademark dilution arising under 15  
 22 U.S.C. § 1125(c), (d) trademark infringement arising under the  
 23 common law of the State of California, and (f) unfair competition  
 24 arising under California Business & Professions Code  
 25 § 17200.

26 5. This Court has original subject matter jurisdiction  
 27 pursuant to 15 U.S.C. §§ 1116(a) and 1121(a) and 28 U.S.C. §§ 1331  
 28 and 1338 over the claims arising under the laws of the United

1 States. This Court has supplemental jurisdiction over the remaining  
2 claims in this Complaint pursuant to 28 U.S.C. § 1367(a) because  
3 the state law claims are so related to the federal claims that they  
4 form part of the same case or controversy and derive from a common  
5 nucleus of operative facts.

6 6. This Court has personal jurisdiction over Defendant  
7 because Defendant has a continuous, systematic, and substantial  
8 presence within this judicial district including by regularly doing  
9 and soliciting business and deriving revenue from goods provided to  
10 individuals in this judicial district, including but not limited to  
11 selling infringing eyewear directly to consumers and/or retailers  
12 in this district and selling into the stream of commerce knowing  
13 such eyewear products would be sold in California and this  
14 district, which acts form a substantial part of the events or  
15 omissions giving rise to Luxottica's claim.

16 7. Venue is proper in this judicial district under 28 U.S.C.  
17 § 1391 (b)-(d).

### 18 III.

#### 19 GENERAL ALLEGATIONS

20 8. Luxottica is a well-known and established manufacturer,  
21 distributor and retailer of high quality eyewear. Many of these  
22 lines of eyewear, such as Ray-Ban®, have enjoyed substantial  
23 success and are protected by various intellectual property rights  
24 owned or licensed by Luxottica.

25 9. Luxottica has marketed and sold its high quality eyewear  
26 in connection with the WAYFARER® mark (the "Luxottica Mark").  
27 Since Luxottica began using the Luxottica Mark, its use of the mark  
28 in connection with eyewear has been continuous and exclusive.

1           10. Over the years Luxottica has invested a considerable  
2 amount of time and money in establishing the Luxottica Mark in the  
3 minds of consumers as a source of high quality eyewear. As a  
4 result of Luxottica's substantial use and promotion of the  
5 Luxottica Mark in connection with the eyewear and other products,  
6 the mark has acquired great value as a specific identifier of  
7 Luxottica's products and serves to distinguish Luxottica's products  
8 from that of others. Customers in this Judicial District and  
9 elsewhere readily recognize the Luxottica Mark as distinctive  
10 designations of origin of Luxottica's products. The Luxottica Mark  
11 is an intellectual property asset of great value as a symbol of  
12 Luxottica's quality products and goodwill.

13           11. Luxottica is the owner of Trademark Registration Nos.  
14 595,513 for the Luxottica Mark.

15           12. Trademark Registration No. 595,513 was registered with  
16 the U.S.P.T.O. on September 21, 1954. Trademark Registration No.  
17 595,513 is associated with the following goods: sunglasses. A true  
18 and correct copy of the certificate of registration of Trademark  
19 Registration No. 595,513 is attached hereto as Exhibit A.

20           13. Without permission or consent from Luxottica, Defendant  
21 is offering for sale, distributing, marketing, and/or selling  
22 eyewear bearing the Luxottica Mark.

23           14. Defendant did not begin using its infringing mark in  
24 connection with eyewear until long after Luxottica began using the  
25 Luxottica Mark.

26           15. Luxottica is informed and believes, and on that basis  
27 alleges, that Defendant's unauthorized use of its infringing mark  
28 is intended to trade upon the goodwill and substantial recognition

1 associated with Luxottica and the Luxottica Mark.

2 16. Luxottica is informed and believes, and on that basis  
3 alleges, that Defendant is using its infringing mark in an attempt  
4 to associate its eyewear products with Luxottica and the Luxottica  
5 Mark, to cause mistake or deception as to the source of Defendant's  
6 eyewear products and/or to otherwise trade upon Luxottica's  
7 valuable reputation and customer goodwill in its mark.

8 17. Luxottica is informed and believes, and on that basis  
9 alleges, that Defendant's use of its infringing mark is designed to  
10 cause confusion, mistake, or deception.

11 18. By virtue of the acts complained of herein, Defendant has  
12 created a likelihood of injury to Luxottica's business reputation,  
13 caused a strong likelihood of consumer confusion, mistake, and  
14 deception as to the source of or origin or relationship of  
15 Luxottica's and Defendant's goods, has caused actual confusion, and  
16 has otherwise competed unfairly with Luxottica by unlawfully  
17 trading on and using the Luxottica Mark without Luxottica's  
18 permission or consent.

19 19. At no time has Luxottica ever given Defendant license,  
20 permission or authority to use or display the Luxottica Mark in  
21 connection with any of Defendant's eyewear products.

22 20. Luxottica is informed and believes, and on that basis  
23 alleges, that Defendant's acts complained of herein are willful and  
24 deliberate.

25 21. Defendant's acts complained of herein have caused  
26 Luxottica to suffer irreparable injury to its business. Luxottica  
27 will suffer substantial loss of goodwill and reputation unless and  
28

1 until Defendant is preliminarily and permanently enjoined from its  
2 wrongful actions complained of herein.

3  
4 **IV.**

5 **FIRST CLAIM FOR RELIEF**

6 **(Federal Trademark Infringement)**

7 **(15 U.S.C. § 1114)**

8 22. Luxottica repeats and re-alleges the allegations of  
9 paragraphs 1- 22 of this Complaint as if set forth fully herein.

10 23. This is a claim for trademark infringement arising under  
11 15 U.S.C. § 1114.

12 24. Defendant has used in commerce, without Luxottica's  
13 permission, reproductions, copies or colorable imitations of the  
14 Luxottica Mark in connection with distributing, selling, offering  
15 for sale, advertising, and/or promoting Defendant's eyewear.

16 25. Without Luxottica's permission, Defendant is reproducing,  
17 copying, or colorably imitating the Luxottica Mark and applying  
18 such reproductions, copies or colorable imitations to merchandise,  
19 labels, signs, packages, receptacles or advertisements intended to  
20 be used in commerce upon or in connection with the distributing,  
21 selling, offering for sale, advertising and/or promoting of goods  
22 or services on or in connection with which such use is likely to  
23 cause confusion, or to cause mistake, or to deceive.

24 26. Luxottica is informed and believes, and on that basis  
25 alleges, that Defendant's activities complained of herein  
26 constitute willful and intentional infringements of the Luxottica  
27 Mark, and that Defendant did so with the intent to unfairly compete  
28 against Luxottica, to trade upon Luxottica's reputation and

1 goodwill by causing confusion and mistake among customers and the  
2 public, and to deceive the public into believing that Defendant's  
3 eyewear products are associated with, sponsored by, originated  
4 from, or are approved by Luxottica, when in truth and fact they are  
5 not.

6 27. Luxottica is informed and believes, and on that basis  
7 alleges, that Defendant had actual knowledge of Luxottica's  
8 ownership and prior use of the Luxottica Mark and without the  
9 consent of Luxottica has willfully infringed the Luxottica Mark in  
10 violation of 15 U.S.C. § 1114.

11 28. Luxottica is informed and believes, and thereon alleges,  
12 that Defendant has derived and received, and will continue to  
13 derive and receive, gains, profits, and advantages from the use of  
14 the Luxottica Mark in an amount that is not presently known to  
15 Luxottica. By reason of Defendant's actions, constituting  
16 unauthorized use of the Luxottica Mark, Luxottica has been damaged  
17 and is entitled to monetary relief in an amount to be determined at  
18 trial.

19 29. Due to Defendant's actions, constituting unauthorized use  
20 of the Luxottica Mark, Luxottica has suffered and continues to  
21 suffer great and irreparable injury, for which Luxottica has no  
22 adequate remedy at law.

23 V.

24 **SECOND CLAIM FOR RELIEF**

25 **(Federal Unfair Competition & False Designation of Origin)**

26 **15 U.S.C. § 1125(a))**

27 30. Luxottica repeats and realleges the allegations of  
28 paragraphs 1-22 of this complaint as if set forth fully herein.

1           31. This is a claim for unfair competition and false  
2 designation of origin arising under 15 U.S.C. § 1125(a).

3           32. Without Luxottica's consent, Defendant has created and  
4 will create a false designation of origin by using in commerce the  
5 Luxottica Mark and/or other marks confusingly similar to the  
6 Luxottica Mark in connection with the distribution, sale, offering  
7 for sale, advertising, and/or promotion of Defendant's eyewear,  
8 thereby causing a likelihood of confusion, mistake or deception as  
9 to an affiliation, connection or association with Luxottica or to  
10 suggest Luxottica as the origin of the goods and/or services, or  
11 that Luxottica has sponsored or approved Defendant's commercial  
12 activities.

13           33. Luxottica is informed and believes, and on that basis  
14 alleges, that Defendant acted with the intent to unfairly compete  
15 against Luxottica, to trade upon Luxottica's reputation and  
16 goodwill by causing confusion and mistake among customers and the  
17 public, and to deceive the public into believing that Defendant's  
18 eyewear products are associated with, sponsored by or approved by  
19 Luxottica, when they are not.

20           34. Luxottica is informed and believes, and on that basis  
21 alleges, that Defendant had knowledge of Luxottica's ownership and  
22 prior use of the Luxottica Mark, and without the consent of  
23 Luxottica, has willfully committed acts of unfair competition and  
24 false designation of origin in violation of 15 U.S.C. § 1125(a).

25           35. Luxottica is informed and believes, and thereon alleges,  
26 that Defendant has derived and received, and will continue to  
27 derive and receive, gains, profits, and advantages from Defendant's  
28 false designation of origin, false or misleading statements,



1 descriptions of fact, or false or misleading representations of  
2 fact in an amount that is not presently known to Luxottica. By  
3 reason of Defendant's actions, constituting false designation of  
4 origin, false or misleading statements, false or misleading  
5 descriptions of fact, or false or misleading representations of  
6 fact, Luxottica has been damaged and is entitled to monetary relief  
7 in an amount to be determined at trial.

8  
9 36. Due to Defendant's actions, constituting false  
10 designation of origin, false or misleading statements, false or  
11 misleading description of fact, or false or misleading  
12 representations of fact, Luxottica has suffered and continues to  
13 suffer great and irreparable injury, for which Luxottica has no  
14 adequate remedy at law.

15 **VI.**

16 **THIRD CLAIM FOR RELIEF**

17 **(Federal Trademark Dilution)**

18 **(15 U.S.C. § 1125(c))**

19 37. Luxottica repeats and re-alleges the allegations of  
20 paragraphs 1-37 of this Complaint as if set forth fully herein.

21 38. This is a claim for trademark dilution under 15 U.S.C. §  
22 1125(c).

23 39. The products sold by Luxottica under the Luxottica Mark  
24 have been widely advertised, promoted, and distributed to the  
25 purchasing public throughout the United States and the world.

26 40. Luxottica's products sold under the Luxottica Mark, by  
27 reason of their style and design and quality of workmanship, have  
28 come to be known to the purchasing public throughout the United

1 States as high quality products, which are sold under excellent  
2 merchandising and customer service conditions. As a result, the  
3 Luxottica Mark, and the goodwill associated therewith, are of great  
4 value to Luxottica.

5 41. By virtue of the wide renown acquired by the Luxottica  
6 Mark, coupled with the national and international distribution and  
7 extensive sale of various products distributed under the Luxottica  
8 Mark, the Luxottica Mark is famous and became so prior to  
9 Defendant's acts complained of herein.

10  
11 42. Defendant's unauthorized commercial use of the Luxottica  
12 Mark in connection with the advertisement, offering for sale and  
13 sale of Defendant's eyewear products has caused and is likely to  
14 continue to cause dilution of the distinctive quality of the famous  
15 Luxottica Mark.

16 43. Defendant's acts are likely to tarnish, injure, or trade  
17 upon Luxottica's business, reputation or goodwill, and to deprive  
18 Luxottica of the ability to control the use of its Luxottica Mark  
19 and quality of products associated therewith.

20 44. Luxottica is informed and believes, and on that basis  
21 alleges, that Defendant's dilution has been willful and deliberate.

22 45. By reason of the aforesaid acts constituting trademark  
23 dilution, Luxottica has been damaged and is entitled to monetary  
24 relief in an amount to be determined at trial.

25 46. Due to Defendant's actions, constituting trademark  
26 dilution, Luxottica has suffered and continues to suffer great and  
27 irreparable injury, for which Luxottica has no adequate remedy at  
28 law.

VII.

FOURTH CLAIM FOR RELIEF

(California Common Law Trademark Infringement)

47. Luxottica repeats and re-alleges the allegations of paragraphs 1-47 of this Complaint as if set forth fully herein.

48. This is a claim for trademark infringement, arising under California common law.

49. Defendant's acts complained of herein constitute trademark infringement under California common law. Defendant's acts complained of herein are willful and deliberate and committed with knowledge that Defendant's unauthorized use of the Luxottica Mark causes a likelihood of confusion.

50. Luxottica is informed and believes, and thereon alleges, that Defendant has derived and received and will continue to derive and receive, gains, profits and advantages from Defendant's trademark infringement in an amount that is not presently known to Luxottica. By reason of Defendant's wrongful acts as alleged in this Complaint, Luxottica has been damaged and is entitled to monetary relief in an amount to be determined at trial.

51. Due to Defendant's trademark infringement, Luxottica has suffered and continues to suffer great and irreparable injury for which Luxottica has no adequate remedy at law.

52. Defendant's willful acts of trademark infringement under California common law constitute fraud, oppression, and malice. Accordingly, Luxottica is entitled to exemplary damages.

VIII.

FIFTH CLAIM FOR RELIEF

(California Unfair Competition)



1           2. A preliminary and permanent injunction against Defendant,  
 2 its officers, agents, servants, employees, representatives,  
 3 successors, and assigns, and all persons, firms, or corporations in  
 4 active concert or participation with Defendant, enjoining them from  
 5 engaging in the following activities and from assisting or  
 6 inducing, directly or indirectly, others to engage in the following  
 7 activities:

8           A. using to market, advertise, promote, sell, offer for  
 9 sale, and/or identify Defendant's goods with the  
 10 Luxottica Mark or any mark that is confusingly similar  
 11 to the Luxottica Mark or is likely to create the  
 12 erroneous impression that Defendant's goods or services  
 13 originate from Luxottica, are endorsed by Luxottica, or  
 14 are connected in any way with Luxottica;

15           B. manufacturing, distributing, shipping, importing,  
 16 reproducing, displaying, advertising, marketing,  
 17 promoting, transferring, selling, and/or offering to  
 18 sell any eyewear products bearing any of the Luxottica  
 19 Mark and/or any confusingly similar marks;

20           C. otherwise infringing or diluting the Luxottica Mark  
 21 and/or any of Luxottica's other trademarks;

22           D. falsely designating the origin of Defendant's goods;

23           E. unfairly competing with Luxottica in any manner; or

24           F. causing a likelihood of confusion or injuries to  
 25 Luxottica's business reputation;

26           3. That Defendant be directed to file with this Court and  
 27 serve on Luxottica within thirty (30) days after the service of the  
 28 injunction, a report, in writing, under oath, setting forth in

1 detail the manner and form in which Defendant has complied with the  
2 injunction pursuant to 15 U.S.C. § 1116;

3 4. That, because of the exceptional nature of this case  
4 resulting from Defendant's deliberate infringing actions, this  
5 Court award to Luxottica all reasonable attorneys' fees, costs and  
6 disbursements incurred as a result of this action, pursuant to 15  
7 U.S.C. § 1117;

8 5. That Defendant be required to account for any and all  
9 profits derived by its acts of trademark infringement, false  
10 designation of origin, trademark dilution, and unfair competition  
11 complained of in this Complaint;

12 6. That Luxottica be awarded damages for Defendant's  
13 trademark infringement pursuant to 15 U.S.C. § 1117 in the form of  
14 Defendant's profits, damages sustained by Luxottica and the costs  
15 of the action, together with prejudgment and post-judgment  
16 interest;

17 7. That Defendant's acts of trademark infringement, false  
18 designation of origin, trademark dilution, and unfair competition  
19 complained of in this Complaint be deemed willful, and that  
20 Luxottica be entitled to enhanced damages;

21 8. That Defendant be adjudged to have acted with willful  
22 intent to trade on Luxottica's reputation and to dilute the famous  
23 Luxottica Mark in violation of 15 U.S.C. § 1125(c), et seq.;

24 9. That Defendant be adjudged to have willfully and  
25 maliciously infringed the Luxottica Mark in violation of  
26 Luxottica's common law rights under California common law;

27 10. That Defendant be adjudged to have violated California  
28 Business & Professional Code § 14247 by seeking to injure

1 Luxottica's business reputation and to dilute the distinctive  
2 quality of the Luxottica Mark;

3 11. That Defendant be adjudged to have competed unfairly with  
4 Luxottica under the common law of the State of California;

5 12. That Defendant be adjudged to have competed unfairly with  
6 Luxottica under California Business & Professional Code § 17200,  
7 and that Defendant's actions in so doing be adjudged willful and  
8 done knowingly;

9 13. That an accounting be ordered to determine Defendant's  
10 profits resulting from its infringement, unfair competition,  
11 dilution, and false designation of origin, and that Luxottica be  
12 awarded monetary relief in an amount to be fixed by the Court in  
13 its discretion as it finds just as an equitable remedy, including:

14 A. all profits received by Defendant from sales and  
15 revenues of any kind made as a result of its  
16 infringing actions, said amount to be trebled;

17 B. all damages sustained by Luxottica as a result of  
18 Defendant's acts of infringement, unfair  
19 competition, false designation of origin, and  
20 dilution, and that such damages be trebled; and

21 C. punitive damages stemming from Defendant's willful,  
22 intentional, and malicious acts;

23 14. That such damages and profits be trebled and awarded to  
24 Luxottica pursuant to 15 U.S.C. § 1117;

25 15. That Luxottica recover exemplary damages pursuant to  
26 California Civil Code § 3294;

27 16. That Luxottica have and recover the costs of this civil  
28 action, including reasonable attorneys' fees;

1           17. An award of pre-judgment and post-judgment interest and  
2 costs of this action against Defendant; and

3           18. Such other and further relief as this Court may deem just  
4 and proper.

5 Dated: July 23, 2015

CHRISTOPHER L. PITET  
JOHN M. ALPAY  
GROBATY & PITET LLP

6  
7  
8 By: /s/ Christopher L. Pitet  
9 Christopher L. Pitet

10 Attorneys for Plaintiff  
11 LUXOTTICA GROUP S.P.A.  
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**DEMAND FOR JURY TRIAL**

Plaintiff Luxottica Group S.P.A. hereby demands a trial by jury on all issues triable by a jury as provided by Rule 38(a) of the Federal Rules of Civil Procedure.

Dated: July 23, 2015

CHRISTOPHER L. PITET  
JOHN M. ALPAY  
GROBATY & PITET LLP

By: /s/ Christopher L. Pitet  
Christopher L. Pitet

Attorneys for Plaintiff  
LUXOTTICA GROUP S.P.A.